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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,190	03/11/2004	James M. Hume	P-121896.0002.032	5304
7590 Robert C. Curfiss Jackson Walker L.L.P. Suite 2100 112 E. Pecan San Antonio, TX 78205			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT 1762	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/798,190

Applicant(s)

HUME, JAMES M.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-23,26-32,37-39 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23,26-32,37-39 and 42 is/are allowed.
- 6) ☒ Claim(s) 18-22 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/2006 has been entered.

### ***Response to Amendment***

2. Claims 18-23, 26-32, 37-39, 41, and 42 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 18-22 and 41, set-forth in the final Office action mailed 7/7/2006, have been considered but are moot in view of the new ground(s) of rejection set-forth below in response to applicant's amendment to claim 18, filed 12/12/2006.

4. Applicant's arguments, see the remarks, filed 12/12/2006, with respect to the rejection of claims 23, 26-32, 37-39, and 42, set-forth in the final Office action mailed 7/7/2006, have been fully considered in light of applicant's amendment filed 12/12/2006 and are persuasive. Applicant has amended independent claim 23 to recite an embodiment fully supported by the originally-filed specification (see paragraph 2 of the final Office action mailed 7/7/2006). The rejection of claims 23, 26-32, 37-39, and 42 has been withdrawn and these claims are in condition for allowance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 18-22 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. Claim 18 has been amended to recite the second embodiment of applicant's invention, set-forth at 8:12-9:19 of the specification. This embodiment applies liner 10 to the concrete substrate. Liner 10 includes first barrier layer 12, surfacer layer 13, and second barrier layer 14. Applicant claims:

- (b) applying a foam liner material to said surface of said concrete structure wherein said foam liner material comprises an epoxy; and
- (c) applying a surfacer layer on said foam liner material; and
- (d) applying a barrier layer on said surfacer layer.

The examiner presumes that foam liner (b) corresponds to first barrier layer 12, that surfacer layer (c) corresponds to surfacer layer 13, and that barrier layer (d) corresponds to second barrier layer 14. The originally-filed application fails to support the characterization of first barrier layer 12/foam liner (b) as comprising an epoxy. With respect to this layer, the originally-filed specification discloses:

In a second embodiment of the invention, as shown in FIG. 2, the liner 10 is composed of a first barrier layer 12, a surfacer layer 13 and a second barrier layer 14. The barrier layers have the same properties as described for the barrier layer of the first embodiment. Likewise, the surfacer layer 13 of the second embodiment is identical to the surfacer layer 25 of the first embodiment.

The barrier layer of the first embodiment is disclosed as follows:

The barrier layer 30 may a polymer blend of separate components which are mixed as they exit the spray nozzle, the components reacting to form a hard material upon curing. Preferably, a blend of polyurea component and an isocyanate component is utilized, with the two components formulated to have similar viscosities. In an alternate embodiment, the barrier layer 30 may be a polyurea foam. Preferably, the barrier layer 30 is applied to a dry film thickness of preferably

The only foam material disclosed in conjunction with first barrier layer 12/foam liner (b) is a polyurea foam. As such applicant's claimed "foam liner material" is not supported by the disclosure as originally-filed.

B. Further, claim 20 recites a polyurethane foam liner material, which is also not supported by the originally-filed disclosure for the same reasons set-forth above.

#### ***Allowable Subject Matter***

7. Claims 23, 26-32, 37-39, and 42 are allowed.

8. The following is an examiner's statement of reasons for allowance: As stated in prior Office actions, while self-skinning foam layers are known, the prior art neither teaches nor suggests the claimed process in which a single foam layer cures into three distinct layers.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Condo et al. (US 3,986,781 A).

10. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III  
Primary Examiner  
Art Unit 1762

January 4, 2007